REMARKS

This paper is responsive to the final Office Action mailed October 30, 2007, relating to the above-identified application. Applicant has amended the claims in response to the Examiner's unsupported claims that one of ordinary skill in the art understands the different steps of the method and believes Applicant's code lot is somehow analogous to skill levels. As amended, claims 21 and 84–105 are allowable for the reasons set below.

I. The Examiner's Rejections

Independent claim 21 and dependant claims 84–105 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,509,064 to Welner ("Welner") in view of U.S. Patent No. 6,222,919 to Hollatz et al. ("Hollatz"). Claims 96–97 stand rejected as being unpatentable over Welner in view of Hollatz et al. in further view of U.S. Patent No. 5,890,492 to Elmaleh ("Elmaleh").

II. Applicant's Response

This prosecution stems from conflicting interpretations of MPEP § 2111. The Examiner gives Applicant's claims their broadest reasonable interpretation based on what was read in the prior art, and Applicant wants the Examiner to give the claims "their broadest reasonable interpretation consistent with the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). The words of Applicant's claims must be given their "plain meaning" unless such meaning is inconsistent with the specification. MPEP § 2111.01.I. This plain meaning is determined by the meanings words would have to one of

ordinary skill in the art. MPEP § 2111.01.III. Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) cited in MPEP § 2144.03(B). Otherwise, the Applicant must timely note that the record is lacking and the conclusion of the Examiner is not fully supported. The Examiner's conclusions are not supported by any evidence.

The procedure for relying on common knowledge is a finding of fact of "substantial evidence." *In re Gartside*, 203 F.3d 1305 (Fed. Cir. 2000). "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." *In re Zurko*, 258 F3d 1379, 1385 (Fed. Cir. 2001) cited in MPEP § 2144.03A. Applicant once again reasserts and timely challenges these determinations.

The Examiner argues that "code lots" and "skill levels" are analogous for one of ordinary skill in the art. No evidence is given in support of this position. The Examiner also argues that to talk to a counselor and hang up the call corresponds to one of ordinary skill in the art to the same as making an informed decision if a counselor is needed and once the counselor is on the phone to hang-up. For example, in the art of telemarketing, the automatic connection of a telemarketer with the client capable of telling the telemarketer that marketing is not desired surely cannot be equal to a system where the user decides if talking to the telemarketer is desired. This is one art where these steps are easily distinguishable. For this reason, the Examiner must

prove that, for this art, the processes are different. Substantial evidence must be entered in the record. Also, Applicant respectfully believes "code lots" are not "skill levels" and differ greatly to one of ordinary skill in the art. The use of code lots is explained in the specification and should be read accordingly. Code lots associate counselors without the need of "skill levels."

Nevertheless, Applicant amends independent claim 21 and dependent claims 84–105 to include limitations from the specification that would otherwise be read in the claims when the words are read "in light of the specification." At p. 15 of the October 30, 2007, Office Action, the Examiner explains as follows:

> "Furthermore, the claim language merely recites, 'in any order querying said user as to whether said user desires counseling' therefore Welner's transferring a caller to a CRS to obtain general information is a form of counseling since the user may decline to receive the general information and thereby meets the claim limitation."

Applicant amends claim 21 to specifically define from language fully enabled in the specification what type of counseling is contemplated. Applicant's specification provides the following:

> For example, the counseling provided to the user may be more specifically tailored to the user if it is know that the user works for a particular company or in a particular industry. In addition, where the counselor knows that the user works for a specific company, the counselor may be able to provide the user with information relating to the user's insurance benefits. Page 3, ll. 10–20.
>
> Persons who receive a positive test result are provided with counseling referrals and support, and are referred to a physician for medial follow up at steps 107 and 108 respectively. Page 8, ll. 1–3.
>
> As shown at step 213, if the test result is negative, the client is counseled to structure his or her activities to reduce future risk. Upon receipt of a positive or indeterminate result, the client is instructed to enter physician care for further medical evaluation and follow-up, as shown at step 215. Page 8, ll. 20–23.

As a consequence, Applicant has amended the claim to the following:

> In a testing system, a method for routing a plurality of incoming inquiries initiated by a plurality of users, said users submitting test specimens for evaluation to a testing facility, each of said users being associated with a personal identification code, said personal identification code being associated with a code database comprising a plurality of codes in which at least one subset of said plurality of codes is associated with a code lot, the method comprising the steps of: receiving an inquiry initiated by one of said users; prompting said user to transmit said personal identification code; receiving said personal identification code; in any order querying said user as to whether said user desires counseling; and determining whether said personal identification code input by said user corresponds to a code lot; from among a plurality of counselors, including at least one counselor associated with said lot, selecting a counselor associated with said lot if said personal identification code is determined to be associated with said lot; and routing said inquiry to said counselor,
>
> wherein said counseling is tailored to the user and includes information relating to the user's insurance benefits, and provide activities to reduce risk if a result of the test specimen is negative, and instruction to enter physician care for further medical evaluation and follow-up if the result of the test specimen is positive or indeterminate.

Next, the Examiner agrees that code lots are not disclosed in the references but that, when viewed in the context of the common knowledge of average skill in the art, these lots can be associated with skill levels. (Office Action, p. 15.) No documentary evidence is given and the underlying decision as to where skill levels and code lots are associated is not given. Applicant further amends claim 21 and the dependant claims where applicable to replace the term "code lot" with "code lot for the employees of a specific company." Applicant directs the Examiner to p. 3, ll. 13–14 where this language is found expressly in the specification.

Applicant believes that the skill levels of operators (i.e., speaking French, being a specialist in a field, having HIV knowledge) cannot reasonably be associated by one of ordinary skill in the art with "code lot for the employees of

a specific company." To allocate to a counselor a code lot company specific (e.g., Lowes, Sears, etc.) is not based on a skill or a skill level. To the contrary, this determination does not require skill on the part of the counselor. A reference that teaches the use of specific counselors with specific skills cannot be analogized to the use of code lots unless substantial evidence is entered into the record to support this position.

III. Conclusion

The *prima facie* case under § 103(a) is improper since it relies on the knowledge of one of ordinary skill in the art and is unsupported by evidence. All remaining claims 21 and 84–105 are allowable since the prior art fails to disclose the new limitations. Applicant believes these amendments place claims 21 and 84–105 in condition of allowance at this advisory action level and requests allowance from the Examiner.

The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 22-0259 or any payment in connection with this communication, including any fees for extension of time, that may be required. The Examiner is invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,

Dated: December 28, 2007

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